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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,804	12/18/1998	MARK GAVIN	D3239-00002	1595

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EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/18/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/215,804

Applicant(s)

GAVIN ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-14, 16-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14, 16-22, 24-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: RCE filed 8/25/2003, to the original application filed 12/18/1998.
2. Claims 1-6, 8-14, 16-22, 24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson.
3. Claims 1-6, 8-14, 16-22, 24-25 are pending. Claims 1, 5, 9, 13, 17, 21, 25 are independent claims.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/25/2003 has been entered.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 8-14, 16-22, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (hereinafter Anderson), U.S. Patent No. 5,581,682 issued December 3, 1996.

In regard to independent claim 1, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 1 preamble “*A method of redacting content from a document in electronic form, comprising the steps of*”).

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or area of content to be redacted (Anderson Figures 1, 3B, 5 also column 3 lines 33-39, column 7 Table II line “Object Area Position”; compare with claim 1 “*selecting a geometric area on the document for redaction, said geometric area having content*”, and “*representing said geometric area as one or more annotation objects*”). Anderson does not specifically teach said Overlay Object annotation as a source for redaction, as claimed. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (and providing the claimed equivalent of an overlay object annotation as a source for redaction) (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects (Anderson Figure 1, 3B, also column 6 lines 15-20; compare with claim 1 “*identifying information in the document representing content and location and nature of content*”, and “*representing said identified information as one or more content objects*”).

Anderson teaches a final-form document with annotated and/or redacted areas present in said document, with content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 1 “*identifying content....to produce a redacted document.*”).

Anderson does not specifically disclose “an output file” with said content not present, as claimed. However, Anderson teaches that, although the underlying document as archived is not changed, however, a reviewer with a low security clearance may see only the redacted version of said document (Anderson column 2 lines 43-47), providing the claimed equivalent of an outputted redacted document (with content not present), because the redacted version is the final output document from the point of view of said reviewer. It would have

been obvious to one of ordinary skill in the art at the time of the invention to interpret Anderson in this fashion, providing a user of Anderson the benefit of a document displayed in various levels of redaction. For security purposes (compare with claim 1 “*creating an output file, said identified content not present in said output file, to produce a redacted document.*”).

In regard to dependent claims 2, 3, Anderson teaches items of information (including text) associated with an annotation object (Anderson column 6 lines 12-21; compare with claims 2, 3).

In regard to dependent claim 4, Anderson teaches a final-form document with annotated and/or redacted are present in said document, content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 4).

In regard to independent claim 5, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 5 preamble “*A method of designating portions of a document for redaction, comprising the steps of*”).

Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with claim 5 “*displaying all or a portion of the document*”).

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or redaction (Anderson Figures 1, 3B, 5, also column 3 lines 33-39, column 7 Table II line “Object Area Position”; compare with claim 5 “*designating a geographical region of the document for redaction*”). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects producing a final-form document with annotated and/or redacted areas are present in said document (Anderson Abstract, column 2 lines 25-30, Figure 1, 3B, also column 6 lines 15-20, column 5 lines 47-52; compare with claim 5 “*saving the designations with the document*”).

The limitation of a frame with content having a geographical location within said frame, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4; compare with claim 5 “*wherein the step of designating comprises manipulating a frame displayed on the document, content....visible to the user during said step of manipulation.*”), suggesting the manipulation and orientation (framing) of an object on a page, providing the advantage of visually orientating content objects in relation to the rest of the document.

Applying the above limitation regarding manipulation of a frame, to a redaction, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches application of overlays to both annotations and redactions (see Anderson Figure 5). Since a document annotation can be subject to redaction, it would have been obvious to add and/or combine the redaction overlay with the annotation overlay, providing the advantage of extra security via redaction of user annotations.

In regard to dependent claim 6, Anderson teaches the use of descriptions and stored as offsets (Anderson columns 4 lines 12-24, columns 6-9 Tables I - III; compare with claim 6).

In regard to dependent claim 8, Anderson does not specifically teach batch designation. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches include structures within a page, with more than one include structure per page (for each annotation/redaction) (Anderson column 3 lines 40-48). Anderson also teaches a state register set if default is for a user to view all annotations on a page (Anderson column 5 lines 28-35; compare the above

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with claim 8), suggesting the processing of annotations/redactions as performed in a batch manner, providing the advantage of batch (all at once) processing.

In regard to claims 9-12, claims 9-12 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 1-4, and are rejected along the same rationale.

In regard to claims 13-14, 16, claims 13-14, 16 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 5-6, 8, and are rejected along the same rationale.

In regard to claims 17-20, claims 17-20 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 1-4, and are rejected along the same rationale.

In regard to claims 21-22, 24, claims 21-22, 24 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 5-6, 8, and are rejected along the same rationale.

In regard to independent claim 25, Anderson teaches annotation and redaction of an electronic document (Anderson Abstract; compare with claim 25 preamble "*A method of designating portions of a document for redaction, comprising the steps of*").

Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with claim 25 "*displaying all or a portion of the document*").

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation (Anderson Figure 1, 3B, also column 3 lines 33-39, column 7 Table II line "Object Area Position"; compare with claim 25 "*designating a geographical region of the document for redaction*"). Anderson does not specifically teach said

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Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects producing a final-form document with annotated and/or redacted are present in said document (Anderson Abstract, column 2 lines 25-30, Figure 1, 3B, also column 6 lines 15-20, column 5 lines 47-52; compare with claim 25 "*saving the designations with the document*").

The limitation regarding batch designation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches "include" structures within a page, with more than one include structure per page (for each annotation/redaction set) (Anderson column 3 lines 40-48). Anderson also teaches a state register set if default is for a user to view all annotations on a page (Anderson column 5 lines 28-35; compare the above with claim 25 "*wherein said step of designating comprises designating all geographic regions containing content selected by a user for batch designation.*"), suggesting the processing of annotations/redactions as performed in a batch manner, providing the advantage of batch (all at once) processing.

7. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Graham et al.

U.S. Patent No. 6,457,026

issued

09-2003

Response to Arguments

8. It is respectfully noted that, although the same reference is retained in the instant set of rejections, Applicant has amended various claims, resulting in a set of rejections which are modified accordingly.

Applicant's arguments filed 8/25/2003 have been fully and carefully considered but they are not persuasive.

Applicant argues on page 6 of the RCE that Anderson does not teach removal of content from a document, and that only an overlay obscures content designated for redaction. The examiner respectfully notes that, although it appears that Anderson tries to preserve an original document by archiving said document (Anderson column 2 lines 42-45), nevertheless, the final document displayed to a user (of low security level) is in redacted form. It is obvious from said user's point of view that content of the redacted document has been "removed" (even if one assumes said content is merely covered by an opaque overlay, the user sees that the content in question is removed from display). Since saving a document is known in the art, Anderson's invention would be worthless if a user saves a redacted document, only to see the original unaltered version when the redacted document is immediately reopened by the same user. As Applicant correctly states (if it to be assumed that Anderson's overlays cover the content without removing said content), one could possibly reverse-engineer the document to see the original. However, representative claim 1 recites in pertinent part "...*removing said identified content*", and it is obvious to the skilled artisan that redacting (i.e. covering up, or blacking out, etc.) is a form of removing content from a displayed document.

Applicant argues on page 7 of the RCE that the cited reference does not teach the limitations of claim 5, in particular, Anderson allegedly not teaching a displayed frame with content visible to a user within said frame. The examiner respectfully notes that Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document, which at least suggests a frame with user editable content (i.e. some form of GUI or even text based interface which boards a document, etc.).

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Applicant argues on page 7 of the amendment that Anderson does not teach batch designation of content. The examiner notes that Anderson teaches "include" structures within a page, with more than one include structure per page. Anderson also teaches setting a state register if the default is for a user to view all annotations on a page, suggesting batch designation, since all annotations/redactions, etc. are designated.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on (703) 305-9792.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703-872-9306) (for formal/after-final communications intended for entry)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).

William L. Bashore

William L. Bashore
Patent Examiner, AU 2176
December 12, 2003